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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,148

03/06/2002

Kumiko Naito

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01/13/2006

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,148

Applicant(s)

NAITO, KUMIKO

Examiner

Jean M. Corrielus

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2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response the amendment filed on October 27, 2005, in which claims 1-14 are presented for further examination.

#### ***Response to Arguments***

2. Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive. (See examiner's remark section).

#### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to ingredient information management, classified in class 707, subclass 3.

- II. Claim 15, drawn to a system for determining whether a remaining ingredient of a previously used menu is usable as a new ingredient of a currently selected menu, classified in class 705, subclass 10

4. Inventions I, and II are related as sub-combination disclosed as usable together in a single combination. The sub-combinations are distinct from each other if they are shown to be separately usable. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. In the instant case, invention I respectively have separate utility such as determining whether a remaining ingredient of a previously used menu is usable as a new ingredient of a currently

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selected menu, while invention II are useable for ingredient information management. See M.P.E.P. 806.05(d).

5. These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. Restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and the search required for Group II is not required for Group I. Restriction for examination purposes as indicated is proper. The inventions are distinct, each from the other because of the above-mentioned reasons.

7. These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. Restriction for examination purposes as indicated is proper.

***Remark***

8. Newly submitted claim 15 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly claim 15 is are directed to a method for as determining whether a remaining ingredient of a previously used menu is usable as a new ingredient of a currently selected menu, whereas the original claims 1-14 are directed to ingredient information management. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 15 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

9. Applicant asserted that Iwase and Kolawa, alone or in combination, do not teach or suggest usability of a remaining previously used ingredient of one menu as an ingredient of another menu. The examiner disagrees with the precedent assertion. However, when read and analyzed in the light of the specification, the invention as claimed does not support applicants' assertion. Moreover, the claims do not capture the essence of the invention as argued in applicants' remark page 9. Applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. The aforementioned assertions, wherein usability of a remaining previously used ingredient of one menu as an ingredient of another menu fails to disclose by Iwase and Kolawa with regard to the invention of claims 1-8, 13 and 14, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. It is important to note, Applicants' assertions are not explicitly stated in neither of the independent claims 1-8, 13 and 14 nor dependent claims 9-12. There is no mentioned of a usability of a remaining previously used ingredient of one menu as an ingredient of another menu in the claims. Thus, applicants' assertions are just mere allegation with no supported fact. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. Applicants cannot rely on the specification to impart to the claims limitations not recited therein. Such reliance is ineffective to define over the prior art. In re Lundberg, 244 F2d 543, 113 USPQ 530 (CCPA 1957); In re Winklans, 188 USPQ 129 (CCPA 1975). Applicant is further reminded of the clear difference between reading the claims in light

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of the specification as allowed by 35 U.S.C. 112, 6th paragraph, and by *In re Donaldson* 29 USPQ2d, 1845, 16 F.3d 1189 (Fed. Cir, 1994), and reading limitations of the specification into the claims *In re Prater* 415 F2d 1393, 162 USPQ 541 (CCPA 1969). Moreover, the Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater* 162 USPQ 541, 550-51 (CCPA 1969).

Thus, for the above reasons, it is believed that the rejection under 35 U.S.C. 103 provides substantial evidence to support the rationale statement in the above rejection, and the rejection under 35 U.S.C. 103 should be sustained.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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11. Claims 1-4 and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwase et al., (hereinafter "Iwase") US Patent Application Publication no. 2002/0165803.

As to claims 1, 2, 3 and 4, Iwase discloses the claimed "means for receiving the menu information input through member terminals" for receiving a request from a user requesting information on a predetermined disk (page 2, paragraph [0013], lines 5-7); "menu storage means for storing the menu information and amounts of ingredients necessary to prepare each menu indicated in the menu information" means for storing a plurality of disk names and names of the ingredients necessary for making each disk and recipe for each dish (page 2, paragraph [0013], lines 13-16); "ingredient amount searching means for searching out the ingredients and the amounts thereof, from the menu storage means, corresponding to said menu information including previously used ingredients of other menus" (page 2, paragraph [0017], lines 18-27); "sale unit storage means for storing a sale unit for every ingredient, the sale unit of each ingredient being stored in association with the stored menu information including previously used ingredients of the menus" storing the names of the ingredient in the ingredient table, by having stored the ingredient in the ingredient table, the previously used ingredient is also stored in the table for later use (col.6, paragraph [0105] and [0107]). Applicant should duly note that the present invention is directed to obtain menus (new dishes) using remaining ingredients from the previous menu. However, the claimed is directed to such a feature. In addition, Iwase discloses the claimed "sale unit searching means for searching out the sale unit, from the sale unit storage means, corresponding to said ingredient searched out by the ingredient amount searching means" searching the ingredient information database for a dish maker having necessary ingredient (page 2, paragraph [0017], lines 22-29); "comparing means for comparing the amount of said

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ingredient searched out by the ingredient amount searching means with amounts of ingredients corresponding to the sale unit searched by the sale unit searching means and outputting a result indicative thereof” (page 2, paragraph [0013], lines 21-28); and “menu information searching means for searching out the menu information, from the menu storage means, including said ingredient in case that the result indicates that said amount of said ingredient is less than said sale unit” (page 6, paragraph [0111], [0112] and page 8, paragraph [0139]).

As to claims 9, 10, 11 and 12, Iwase discloses the claimed “means for transmitting ingredients of a first menu and a number of distributions of the first menu to a user terminal”[0149]-0152]; and “a means for transmitting ingredients of a second menu inquired in relation to the first menu and a number of the inquiries of the second menu to the user terminal” [0149]-0152].

As to claim 13, Iwase discloses the claimed “storing menu information and amounts of ingredients necessary to prepare each menu indicated in the menu information and storing a sale unit for each ingredient of each menu” (col.6, paragraph [0105] and [0107]; page 2, paragraph [0017], lines 22-29); and “outputting data of an ingredient, a sale unit and an amount of the ingredient upon a menu search, where the amount of the ingredient indicated as a result of the menu search is compared with amounts of ingredients corresponding to the indicated sale unit and an indication is provided when the ingredient indicated is less than the sale unit, the sale unit of each ingredient being stored in association with the stored menu information including substantially similar ingredients of the menus” (page 2, paragraph [0013], lines 21-28; page 6, paragraph [0111], [0112] and page 8, paragraph [0139]). Applicant should duly note that the



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present invention is directed to obtain menus (new dishes) using remaining ingredients from the previous menu.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 5-8 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolawa et al., (hereinafter “Kolawa”) US Patent no. 6,370,513.

As to claims 5, 6, 7, 8 and 14, Kolawa discloses the claimed “storing a first successful sale coefficient representing a probability of purchasing ingredients of a first menu and a second successful sale coefficient representing probability of purchasing ingredients of a second menu inquired in relation to the first menu, the sale unit of each ingredient being stored in association with the stored menu information including substantially similar ingredients of the menus” (col.3, lines 20-32; col.10, lines 7-41; col.11, lines 4-50; col.16, lines 20-52; col.17, lines 20-34, lines 58-63; col.18, lines 10-44; col.20, lines 7-25, lines 40-64; col.21, lines 31-65); “computing expected sales of the ingredients of the first menu based on the ingredients of the first menu, a number of distributions of the first menu, and the successful sale coefficients of the first menu” (col.3, lines 20-32; col.10, lines 7-41; col.11, lines 4-50; col.16, lines 20-52; col.17, lines 20-34, lines 58-63; col.18, lines 10-44; col.20, lines 7-25, lines 40-64; col.21, lines 31-65); “computing the expected sales of the ingredients of the second menu based on the ingredients of the second

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menu, a number of inquiries of the second menu, and the successful sale coefficients of the second menu”(col.3, lines 20-32; col.10, lines 7-41; col.11, lines 4-50; col.16, lines 20-52; col.17, lines 20-34, lines 58-63; col.18, lines 10-44; col.20, lines 7-25, lines 40-64; col.21, lines 31-65). Applicant should duly note that the present invention is directed to obtain menus (new dishes) using remaining ingredients from the previous menu. However, the claimed is directed to such a feature.

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

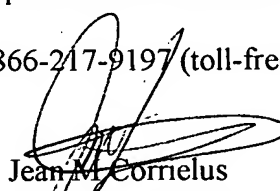
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Cornelius  
Primary Examiner  
Art Unit 2162

January 6, 2006